

REMARKS

The Office Action mailed August 17, 2006 has been carefully considered and the following response prepared. Claims 1-15 are pending in the application. Claims 3, 6-12 and 14-15 have been canceled without prejudice. Claims 1, 2, 4, 5 and 13 have been amended as discussed in detail below.

New claims 16-31 have been added. New claims 16-22 and 24-30 are directed to methods of treating tumors wherein the tumor is selected from the group consisting of lung, renal, prostate, uterine, melanoma and breast tumors. Support for new claims 16-22 and 24-30 can be found throughout the specification and in particular at pages 12 and 19. New claims 23 and 31 are directed to pharmaceutical compositions comprising a compound of claim 1 or claim 2, respectively, and a pharmaceutically acceptable carrier or adjuvant. Support for new claims 23 and 31 can be found throughout the specification and in particular at page 12. No new matter has been added.

Applicants gratefully acknowledge the Examiner's indication at page 7 of the Office Action that the compounds are allowable.

At page 2 of the Office Action, the Examiner objected to the application because it does not contain an abstract on a separate sheet of paper. An abstract on a separate sheet of paper is submitted herewith.

At page 2 of the Office Action, the Examiner rejected claims 1-15 under 35 USC 112, first paragraph as failing to comply with the written description requirement. The Examiner alleged that there was no written description of inclusion compounds or other tumor agents in the specification. Claims 1, 4 and 13 have been amended to delete reference to inclusion compounds. Claim 5 is directed to inclusion compounds with cyclodextrin which Applicants submit complies with the written description requirement. Claims 7 and 14-15 have been canceled without prejudice. Withdrawal of this section 12, first paragraph rejection is respectfully requested.

At page 3 of the Office Action, the Examiner rejected claims 3 and 7-12 under 35 USC 112, first paragraph as failing to comply with the enablement requirement. The Examiner alleged that claim 3 was not enabled for compounds where R2 has a higher water solubility than

compounds where R2 is CH=CH-CH-CH=CH-CH₃. The Examiner also alleged that claims 7-12 were enabled only for methods of treating lung tumors, renal tumors, prostate tumors, uterine tumors and melanoma since exemplified compound 3 was shown to be effective in these tumor cell lines as shown in table 7 on page 19 of the specification.

Applicants traverse this rejection. Claims 3 and 7-12 have been canceled without prejudice. New claims 16-22 and 24-30 are directed to methods of treating a tumor selected from the group consisting of lung, renal, prostate, uterine, melanoma and breast tumors in a patient comprising the step of administering to the patient an amount of a compound of claim 1 or claim 2 effective to treat the tumor. New claims 16-22 and 24-30 are directed to the types of tumors the Examiner indicated were enabled except the claims also include breast tumors. Applicants note that the cell lines used in testing the exemplified compound 3 shown in Table 7 at page 19 of the specification included two breast cancer cell lines, MACL (MCF7) and MAXF (401NL). Applicants therefore submit that breast tumors are also enabled by the specification and have included this type of tumor in new claims 16, 22, 24 and 30. Withdrawal of this section 112, first paragraph is respectfully requested.

At page 5 of the Office Action, the Examiner rejected claims 1-15 under 35 USC 112, second paragraph as indefinite. Each part of the rejection is addressed below.

The Examiner indicated that the group CmH₂m+o-pYp in R2, R5 and R6 of claims 1, 4 and 13 –15 is confusing. Each occurrence of the group CmH₂m+o-pYp in R2, R5 and R6 of claims 1, 4 and 13 has been amended to clarify the meaning of the group by deleting the definitions of m, o, p and Y inserting them at the end of the definition of R2, R5 and R6. Claims 14 and 15 have been canceled without prejudice.

Claims 1, 4 and 13 have been amended to change the term “means” for defining the variables to “is” and the punctuation at the end of the definition of each variable has been changed from a comma to a semi-colon as suggested by the Examiner. Claims 3, 12 and 14-15 have been canceled without prejudice.

The Examiner alleged that the term “inclusion compounds” in claims 1, 4, 5 and 13-15 is indefinite. Reference to “inclusion compounds” has been deleted from claims 1, 4 and 13. Claim 5 is directed to inclusion compounds with cyclodextrin which Applicants submit is not indefinite. Claims 14-15 have been canceled without prejudice.

The Examiner also indicated that the term “residue” in claims 1, 3 and 12 is vague and suggested the Applicants use the term “variables.” Claim 1 has been amended to delete the occurrence of “residue” referring to mono- and di-sugars. “OH residue” has been amended to “OH group.” Claims 3 and 12 have been canceled without prejudice.

The Examiner further alleged that the term “particularly” used in the definition of R2 in claims 4, and 13-15 is indefinite. All occurrences of “particularly” have been deleted from claims 4 and 13. Claims 14 and 15 have been canceled without prejudice.

Claims 6-11 were rejected as indefinite because the terms “drugs” or “preparation of drugs” was unclear. The Examiner suggested amending the claims to recite “pharmaceutical composition.” Claims 6-11 have been canceled without prejudice. New claims 23 and 31 directed to pharmaceutical compositions have been added.

Claim 7 was rejected as indefinite because of the term “further agents”, referring to additional agents for treating tumors, is not defined. Claim 7 has been canceled without prejudice and this part of the present rejection is now moot.

Claims 3 and 12 were rejected as indefinite because they recite the limitation “residues R” in claim 1 or “residues R” in claim 2, respectively. Claims 3 and 12 have been canceled without prejudice and this part of the present rejection is now moot.

Claims 9-11 were rejected as indefinite because they provide for the use of the compounds of claim 1 and do not set out any positive steps for practicing the invention. Claims 9-11 have been canceled without prejudice. New claims 16-22 and 24-30 are directed to methods of treating tumors and contain the active, positive step of administering a compound of claim 1 or claim 2 to a patient having a tumor selected from the group consisting of lung, renal, prostate, uterine, melanoma and breast tumors.

In view of the above, withdrawal of this section 112, second paragraph rejection is respectfully requested.

At page 6 of the Office Action, the Examiner rejected claims 9-11 under 35 USC 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in a claim which is not a proper process claim under 35 USC 101.

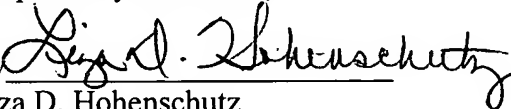
Applicants traverse this rejection. Claims 9-11 have been canceled without prejudice. New claims 16-22 and 24-30 are directed to method of treating tumors and, in accordance with

the requirements of 35 USC 101, contain the step of administering a compound of claim 1 or claim 2 to a patient having a tumor selected from the group consisting of lung, renal, prostate, uterine, melanoma and breast tumors. Withdrawal of this section 101 rejection is respectfully requested.

In view of the above, the present application is believed to be in a condition ready for allowance. Reconsideration of the application is respectfully requested and an early Notice of Allowance is earnestly solicited.

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Respectfully submitted,

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